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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,500	09/12/2003	Chen-Su Huang		5641

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EXAMINER

CHAN, WING F

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 08/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/660,500

Applicant(s)

HUANG, CHEN-SU

Examiner

Wing F. Chan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-8 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited

3. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, page 13, lines 4-5 is vague and indefinite in that the receiving party is dialing the number of the receiving party which does not make sense since the receiving party is dialing his own telephone number which can not make a connection to a different party. Also on page 13, lines 9-10 is vague and indefinite in that the recitation "the calling party receives ringing signals of the calling party" does not make sense. The recitations "Internet protocol A, Internet protocol B" is confusing in that as is known in the art protocols are not transmitted but are used to transmit data, to make a connection, therefore to transmit and receive a protocol is vague and indefinite.

Dependent claims 2-8 are also rejected for the same reason since they are dependent on a rejected base claim and contain the same problem(s).

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 2-4, 6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not provide support for first using the PSTN and then switching over to the Internet (claim 2), "the PSTN connection is disconnected" (claim 3), "the PSTN lines are disconnected" (claim 4). The specification all along discloses using the conventional telephone lines of the PSTN to establish a connection for audio and to use ADSL for video only; there is no disclosure of switching over to the Internet for both audio and video as claimed. Therefore, the specification failed to comply with the written description requirement.

The specification does not provide adequate written description for "any other displaying devices that directly display digital image signals received" (claim 6) since it encompasses all possible conceivable displaying devices while the specification only

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disclosed one single type of display device, e.g. LCD, and nothing else. Therefore, the specification failed to comply with the written description requirement and is non-enabling for failing to disclose all possible displaying devices for performing the stated function.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Lor (US PAT. NO. 6,201,562).

Regarding claim 1, Lor discloses a video telephone integrating public switch telephone network and ADSL comprising a telephone module 404 which reads on the claimed telephone, a control module unit 409, an ADSL module (inter alia packetizer 408, network interface 410 and ADSL modem) for establishing a connection with a called party in response to control by the control module unit. Lor also teaches using Internet address, protocols to establish connection for transmitting audio and video information, e.g. see Lor col. 6 line 40 to col. 7 line 4. Note entire patent.

Regarding claims 2-4, since Lor uses the PSTN and ADSL in the same manner as applicant, it is also inherent in Lor that the PSTN connection is disconnected in the same manner as applicant.

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8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lor in view of Hsieh et al (US PAT. NO. 5,969,750 hereinafter Hsieh).

Lor differs from the claimed invention in not disclosing the use of a LCD display or CCD or CMOS image sensor. However, it is old and well known in the art to use LCD display or CCD or CMOS image sensor in video phone communications, for example see Hsieh col. 6 lines 27-29, col. 11 lines 1-21. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lor to comprise a LCD display for image display, and a CCD or CMOS image sensor for taking the image of the user, to provide for a compact package.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US PAT. NO. 4,533,943; US PAT. NO. 6,209,025; US PAT. NO. 4,387,271; US PAT. NO. 5,675,375.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Examiner W. F. Chan** whose telephone number is 703-305-4732.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached at 703-305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-305-3900.

A handwritten signature in black ink, appearing to read 'Wing F. Chan', is positioned above the printed name.

WING F. CHAN
SENIOR PRIMARY EXAMINER
TECHNOLOGY CENTER 2600

WFC
8/4/04